The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TIMOTHY J. WILKINSON, SCOTT B. GUTHERY
and KSHEERABDHI KRISHNA and MICHAEL A. MONTGOMERY

Appeal No. 2005-0133
Application 10/037,390

ON BRIEF

Before JERRY SMITH, BLANKENSHIP and SAADAT, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 106-118, 120-128, 130-143, 145, 147 and 149. Claims 119, 129, 144, 146 and 148 have been indicated to contain allowable subject matter by the examiner.

The disclosed invention pertains to a method and apparatus that make it possible to develop applications for a microcontroller or an integrated circuit card using a high level language and standard programming tools.

Representative claim 106 is reproduced as follows:

106. A microcontroller comprising:

a memory storing:

a derivative application derived from an application having a class file format wherein the application is derived from an application having a class file format by first compiling the application having a class file format into a compiled form and then converting the compiled form into a converted form, and

an interpreter configured to interpret derivative applications in the converted form and derived from applications having a class file format; and

a processor coupled to the memory, the processor configured to use the interpreter to interpret the derivative application for execution.

The examiner relies on the following references:

Renner et al. (Renner)	5,679,945	Oct. 21, 1997
Peyret et al. (Peyret)	5,923,884	July 13, 1999

Claims 106-118, 120-128, 130-143, 145, 147 and 149 stand rejected under 35 U.S.C. § 103(a). As evidence of obviousness the examiner offers Peyret in view of Renner.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in the claims on appeal. Accordingly, we reverse.

Appellants have indicated that for purposes of this appeal the claims will stand or fall together in the following three groups: Group I has claims 106-114, 118 and 120-126; Group II has claims 115-117, 127, 128, 133-143, 145, 147 and 149; and Group III has claims 119, 129, 144, 146 and 148 [brief, page 2]. Consistent with this indication appellants have made no separate arguments with respect to any of the claims within each group. Accordingly, all the claims within each group will stand or fall

together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Therefore, we will consider the rejection against claims 106, 145 and 119 as representative of all the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore

Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

With respect to representative, independent claim 106, the examiner has indicated how he finds the claimed invention to be rendered obvious by the combined teachings of Peyret and Renner [Office action mailed September 24, 2003, pages 3-4]. Appellants argue that neither Peyret nor Renner teaches the converter that converts the compiled form of an application into

a form suitable for interpretation by a specialized interpreter that interprets derivative applications in the converted form. Appellants assert that in Peyret the byte codes go directly from compilation to interpretation without a conversion step. Appellants argue that the examiner's reliance on Renner to meet the conversion step is misplaced because the conversion in Renner has nothing to do with converting the output of a compiler. Appellants assert, therefore, that there is no motivation in Peyret or Renner to combine their respective teachings. Even though claim 106 does not recite an integrated circuit card, appellants also argue that Peyret is silent on how to enable a program written in a high level language to operate on an integrated circuit card [brief, pages 4-11].

The examiner responds that a "specialized interpreter" is not claimed. The examiner also responds that standard Java provides for the conversion feature when code is compiled on one system and then transferred to another. The examiner asserts that Peyret teaches a reduced interpreter which suggests that some type of converting occurs. The examiner argues that both Peyret and Renner teach the claimed conversion [answer, pages 3-6].

Appellants respond that standard Java only requires the steps of compilation and interpretation, and does not require conversion as claimed. Appellants also assert that the artisan would have assumed that the programs in Peyret were written for the target system so that no conversion would be required or inherent in the Peyret system. Appellants also note again that the type of conversion performed in Renner has nothing to do with the type of conversion recited in representative claim 106 [reply brief, pages 1-6].

We will not sustain the examiner's rejection of representative claim 106 or of any of the other claims included in Group I for essentially the reasons argued by appellants in the briefs. The basic structure of Peyret's system is shown in Figure 2. The source code 46 is compiled into byte code 48 which is fed to software interpreter 42. There is no disclosure in Peyret which suggests that a conversion as claimed occurs between the byte code 48 and the interpreter 42. The command dispatcher or reduced interpreter suggested by Peyret is described as a substitute for the interpreter and virtual machine. There is no suggestion, however, that the reduced interpreter operates to compile an application having a class file format and then convert the compiled form into a converted form. With respect to

Renner, we agree with appellants that the type of conversion described therein has nothing to do with a conversion of compiled applications as recited in claim 106. There is no rational basis for attempting to add the conversion as taught by Renner to the system of Peyret.

With respect to representative, independent claim 145, we find that this claim contains similar limitations to claim 106 considered above as well as additional limitations. Therefore, we will not sustain the examiner's rejection of claim 145 or of any of the other claims of Group II for reasons discussed above. Since all the claims of Group III are claims which depend from claims in Groups I or II, we also do not sustain the rejection of any of the claims in Group III for the reasons discussed above.

In summary, we have not sustained the examiner's rejection with respect to any of the claims on appeal. Therefore, the decision of the examiner rejecting claims 106-118, 120-128, 130-143, 145, 147 and 149 is reversed.

REVERSED

JERRY SMITH)
Administrative Patent Judge)
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HOWARD B. BLANKENSHIP) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
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MAHSHID D. SAADAT)
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